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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/723,549	11/27/2000	Brian Doege	23969-P001US	7916

7590 12/26/2002
Winstead Sechrest & Minick P.C.
Suite 800
100 Congress Avenue
Austin, TX 78701

EXAMINER

BARRY, CHESTER T

ART UNIT	PAPER NUMBER
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1724

DATE MAILED: 12/26/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application N .

09/723,549

Applicant(s)

DOEGE ET AL.

Examiner

Chester T. Barry

Art Unit

1724

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 26 November 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): all but the 35 USC 103(a) rejection.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☒ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: _____.

Claim(s) rejected: 3-5,8-20,27,28,39 and 42-48.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: Notice of Reference Cited

Chester T. Barry
Primary Examiner
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All objections / rejections other than the §103(a) rejection noted at page 9 of the 10/9/02 Office action are withdrawn.

There is no evidence of commercial success. No sales figures are shown on the record. Metro North's setting assignee's product as their "standard" does not evidence adoption of applicants' product as an industry standard. Declarant Doege is an interested party: His statement that Amtrak personnel were skeptical that applicant's product would work is of limited probative value. It is unclear whether those skeptical persons had the education, training and experience, or were otherwise qualified, to render opinions of persuasive effect on the issue of obviousness. It's not clear what conclusion can be drawn from Amtrak and Metro North personnel's vague statement that they had seen "no other product like Bio-Sys's." As for copying by others, there is no showing of facts upon which to show that the claimed invention was copied and not simply independently invented by others.

Please also note the following:

"The Congress shall have Power . . . To promote the Progress of . . . useful Arts, by securing for limited Times to . . . **Inventors** the exclusive Right to their respective . . . Discoveries." U.S. Constitution, Art. I, § 8, clause 8.

"**Whoever invents** or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, . . . " 35 U.S.C. §101

"A **person** shall be entitled to a patent unless . . . " 35 U.S.C. §102.

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"The **applicant** shall make oath that he believes himself to be the original and first **inventor** of the [invention] for which he solicits a patent; and shall state of what country he is a **citizen**." 35 U.S.C. § 115.

"When an invention is made by two or more **persons** jointly, **they** shall **apply** for patent jointly and each make the required oath . . . " 35 U.S.C. §116.

"A patent is applied for in the name or names of the **actual inventor or inventors**." 37 CFR 1.41(a).

"The requirement that the applicant for a patent be the inventor is a characteristic of U.S. patent law not generally shared by other countries." MPEP §2137.01.

Only natural persons can be inventors. Beech Aircraft Corp. v. EDO Corp., 990 F.2d 1237 (Fed. Cir. 1993).

"It is elementary that inventorship and ownership are separate issues." Harmon, "Patents and the Federal Circuit," 3rd ed., BNA Books, 1994, p. 249

Accordingly, the co-inventors are the "applicants" no matter which corporate entity may be the rightful **assignee** of the application. Moreover, there has not been any showing in this case that an inventor has refused to execute the application. Accordingly, the exception to the general rule that inventors (not assignees) are applicants does not apply:

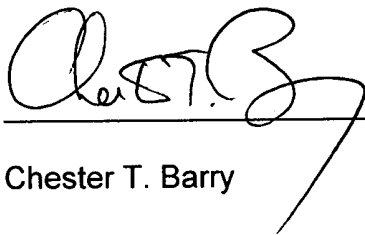
Whenever an inventor refuses to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom the inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for the inventor on proof of the pertinent facts and a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage; and the Director may grant a patent to such inventor upon such notice to him as the Director deems sufficient, and on compliance with such regulations as he prescribes.

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35 U.S.C. §118. If any one of the applicants, i.e., co-inventors Doege, Krell, Brodowicz, and Cooney, or their attorney, is aware of any fact which might cause §118 to apply, please see 37 CFR 1.42 – 1.47 and MPEP § 409.03, and advise the examiner accordingly.

Ref. A – D are cited of interest.

Respectfully,

A handwritten signature in black ink, appearing to read 'C. T. Barry', is written over a horizontal line. The signature is stylized with a large 'C' and a long, sweeping underline that extends to the right.

Chester T. Barry

703-306-5921

12/20/02